

## REMARKS

### **Summary**

Claims 24-26 were pending and all of the claims were rejected in the Office action. Claims 24-26 have been amended to address minor informalities. No new matter has been added. The Applicants have carefully considered the reference and the reasons for rejection advanced by the Examiner and respectfully traverse the rejections in view of the amendments and the discussion presented below. Further, the Applicants respectfully submit that the amendments made in this response are merely grammatical in nature and do not justify a further art search.

### **Specification**

The Examiner has required that a more descriptive title be furnished. In response, the Applicants have made the amendment to the specification presented above.

### **Claim Objections**

Claims 24-26 were objected to on the basis that the preamble begins with "A method". The Examiner objects to this recitation and requires correction to the form "The method." The Applicants have made this change, being merely a matter of an equivalent form of words, as evidenced by the use of the original form in, for example, MPEP§608.01(n). In view of the amendments, the objection has been obviated.

### **Claim Rejections**

#### **35 U.S.C. § 112, second paragraph**

Claims 23-26 were rejected on the basis of 35 U.S.C. § 112, second paragraph as being indefinite. In all of the instances of rejection the substance of the rejection was the use of "the" instead of "a" in introducing the first mention of a dimension of an element recited in the claim. (The Applicants believe that the rejection of Claim 25 is a typographical error as there is no similar recitation.) The Applicants respectfully traverse the rejections, as each of the elements cited is inherent to the structure and

antecedent basis is provided by recitation of the structure itself. MPEP§ 2173.05(e). To expedite the consideration of the application, the claims have been amended to provide explicit antecedent basis, without conceding that such changes are related to patentability.

### **35 U.S.C. §102(e)**

Claims 23, 24 and 26 were rejected under 35 U.S.C. §102(e) as being anticipated by Sasaki (US 6,490,127; "Sasaki").

Claim 23 recites, *inter alia*, (f) the step of forming an upper core layer on the gap layer, the partial insulating layer and the second insulating layer, in which the upper core layer comprises a narrow tip region formed on the gap layer and the partial insulating layer to be exposed with a track width at the surface facing the recording medium, and a rear end region formed on the second insulating layer so that a width dimension [of the rear end region] in the track width direction gradually increases in a backward height direction from an end edge of the tip region.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim*." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir 1984) (citing *Connell v. Sears Roebuck & Co.* 722 F.2d 1542 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

In discussing Sasaki, the Examiner identifies the second insulating layer as element 17, the partial insulating layer as element 13, and the upper core layer as element 14a, as shown in Fig. 6A. As shown in Sasaki Fig. 10, a layer 14a (1-3) is present on the gap layer 12 and the partial insulating layer 13 (layer 14a (3)) only. The upper core layer 14a is not present on the second insulating layer 17, as may be clearly seen in Fig. 6A. Therefore, the Applicants respectfully submit that the Examiner has not made out a *prima facie* case of anticipation, as the reference does not show a rear end region of the upper core layer 14a formed on the second insulating layer 17, using the elements identified as such in Sasaki, and thus the arrangement of elements of the reference differs from that in Claim 23.

When citing the text of Sasaki in support of the rejection, the Examiner points to col 9, line 18 to col 15, line 67. In the event that the Examiner intends to maintain the rejection, the Applicants respectfully request that the specific aspect of the reference which supports the aspect being discussed be cited.

Claims 24 and 26, being claims dependent on an allowable claim are allowable, without more.

**35 U.S.C §103 (a)**

Claim 25 was rejected under 35 U.S.C. §103 (a) as being unpatentable over Sasaki. Claim 25 is a claim dependent on an allowable claim, and is allowable, without more.

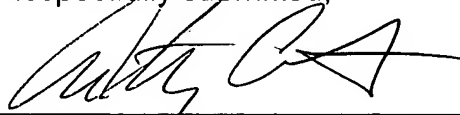
**Conclusion**

Claims 23-26 have been amended and remain pending. —

For at least the reasons given above, the Applicants respectfully submit that the pending claims are allowable.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,



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